

REMARKS

Applicants submit this Reply in response to the non-final Office Action mailed October 15, 2008. Claims 47-84 are submitted for examination, of which claim 47 is the sole independent claim.

In the Office Action, the Examiner rejected claims 47-49, 52-54, 57, 59-66, 68, 70-75, 82, and 83 under 35 U.S.C. § 102(b) as being anticipated by U.S. Pat. No. 5,374,387 ("Barnes"); rejected claims 50, 51, 55, 56, 67, 76-81, and 84 under 35 U.S.C. § 103(a) as being unpatentable over Barnes; and rejected claims 58 and 69 under § 103(a) as being unpatentable over Barnes in view of U.S. Pat. No. 3,984,509 ("Hall").

Applicants respectfully traverse all pending rejections for at least the reasons outlined below.

Rejections Under 35 U.S.C. § 102(b)

Applicants respectfully traverse the rejection of claims 47-49, 52-54, 57, 59-66, 68, 70-75, 82, and 83 under 35 U.S.C. § 102(b) as being anticipated by Barnes. In order to properly establish that Barnes anticipates Applicants' claimed invention under 35 U.S.C. § 102, every element of the claims in issue must be found, either expressly or described under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the... claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Contrary to the assertions in the present Office Action, Barnes does not disclose every element of Applicants' claimed invention. Independent claim 47 recites, in part, "A process for continuously producing an elastomeric composition, comprising . . .

passing the elastomeric composition that results through at least one static mixer."

Applicants' specification, at page 18, lines 19-24, defines a "static mixer" as having no moving parts.

Barnes nowhere appears to disclose such a mixer. Rather, all of the elastomeric composition mixing of Barnes takes place in a continuous extrusion device comprising "a barrel 38 having a pair of central cylinders 40 and a pair of extrusion screws 42 positioned within the cylinders 40." Col. 5, ll. 8-11. The composition is mixed through a rotation of the screws within the barrel. Thus, the extrusion device of Barnes is not a static mixer having no moving parts. As a result, the reference does not disclose, "passing the elastomeric composition that results through at least one static mixer."

In the Office Action, the Examiner states, "Barnes teaches that the process provides a static working volume of material in the batch process which provides static mixing dynamics (passing the elastomeric composition that results through at least one static mixer - Barnes' teachings suggest that the shear mixers used are static mixers [col. 10: 51-56]." (emphasis added).

However, the portion of Barnes to which the Examiner cites is actually discussing a feature of the prior art, not the continuous process taught by the reference. Column 10, lines 51-56 of Barnes states:

As previously indicated, the process of the present invention provides a uniquely different situation from traditional batch mixing processes in that there is, at any productivity rate, a static working volume of material in the batch process which maintains static mixing dynamics and energy flux. The process of the present invention, however, requires sequential additions which change the working volume of the material, with ratios from the initial polymer addition to the finally finished elastomeric composition of 1:2 to 1:3.5. Thus, as previously indicated, the volume of the cavity 40 within each of the mixing zones 12-20 is preferably increased from

zone 12 to 20, preferably in accordance with the particular ratio range just stated." (**emphasis added**).

Barnes further teaches away from the discontinuous batch process of the prior art at column 2, lines 12-19. There, the reference states:

Another limitation of the Banbury-type process involves the volumetric dynamics of the large working volume of this process. Economic necessity dictates that Banbury-type intensive mixers be scaled to the largest size appropriate to the manufacturing operation. As a result, effective volumetric mixing of a high viscosity mass becomes even more difficult." (**emphasis added**).

Thus, by reading in the proper technical context the teachings of Barnes quoted by the Examiner, it is evident that the "static working volume of material" which maintains static mixing dynamics and energy flux discussed at col. 10 of the reference is describing the batch process of the prior art and not the continuous process object of Barnes which, on the contrary, requires sequential additions which change the working volume of the material, with ratios from the initial polymer addition to the finally finished elastomeric composition of 1:2 to 1:3.5.

For at least this reason, Applicants request the Examiner reconsider and withdraw the rejection of independent claim 47 under 35 U.S.C. § 102(b) over Barnes.

Moreover, claims 48, 49, 52-54, 57, 59-66, 68, 70-75, 82, and 83 depend from claim 47 and, thus, contain all the elements and limitations thereof. Accordingly, Applicants also request the Examiner reconsider and withdraw the rejections of dependent claims 48, 49, 52-54, 57, 59-66, 68, 70-75, 82, and 83 as they are allowable at least due to their corresponding dependence from independent claim 47.

Rejections Under 35 U.S.C. § 103(a)

Applying 35 U.S.C. § 103(a), the Examiner also rejected claims 50, 51, 55, 56, 67, 76-81, and 84 as being unpatentable over Barnes; and rejected claims 58 and 69 as

being unpatentable over Barnes in further view of Hall. Applicants respectfully traverse each of these claim rejections because the Office Action has failed to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, "the prior art reference (or references when combined) must teach or suggest all the claim limitations." M.P.E.P. § 2142. Moreover, "in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it [is] necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed." USPTO Memorandum from Margaret A. Focarino, Deputy Commissioner for Patent Operations, May 3, 2007, page 2.

A *prima facie* case of obviousness has not been established because, among other things, neither Barnes, Hall, nor their combination, teaches or suggests every feature of Applicants' claims. As outlined previously herein, Barnes does not teach or suggest at least "passing the elastomeric composition that results through at least one static mixer," as recited in independent claim 47.

The Examiner's citation of Hall fails to cure the deficiencies of Barnes, as Hall similarly fails to disclose "at least one static mixer." Thus, even if the references were combined as the Examiner suggests, they do not teach or suggest all of the elements recited in Applicants' independent claim 47. Claims 50, 51, 55, 56, 58, 67, 69, 76-81, and 84 depend from independent claim 47 and thus, contain all the elements and limitations thereof.

Accordingly, Applicants request the Examiner reconsider and withdraw the rejections of dependent claims 50, 51, 55, 56, 67, 76-81, and 84 under

35 U.S.C. § 103(a) over Barnes and the rejections of dependent claims 58 and 69 under § 103(a) over Barnes in view of Hall.

Claim Scope

It is to be understood that Applicants are in no way intending to limit the scope of the claims to any exemplary embodiments described in the specification, abstract, and/or shown in the drawings. Rather, Applicants believe that they are entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

If the Examiner believes that a telephone conversation might advance prosecution of this application, the Examiner is cordially invited to call Applicants' undersigned attorney at (404) 653-6435.

Applicants respectfully submit that the Office Action contains a number of assertions concerning the related art and the claims. Regardless of whether those assertions are addressed specifically herein, Applicants respectfully decline to automatically subscribe to them.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: April 14, 2009

By: 

Benjamin D. Bailey
Reg. No. 60,539